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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,598

Applicant(s)

HUANG, BEN

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480.

Pan discloses an antimicrobial grip (abstract) comprising an elastomer (abstract) bonded to a textile layer [0010], an elastomer comprising an inorganic antimicrobial agent (Claim 1), a Derwent abstract having the grip formed of polyurethane (Detailed Description), and an inorganic antimicrobial agent comprising tin (Claim 1).

Pan lacks a grip being an elongated strip and an elastomer being polyurethane. 9-75480 discloses a grip being an elongated strip (Derwent Title) and a resin film of foamed polyurethane on a side of fabric (Derwent Abstract). In view of the reference of 9-75480 it would have been obvious to modify the grip of Pan to have a grip being a tape in order to utilize the advantages of Pan for a grip made from a strip. In view of the reference of 9-75480 it would have been obvious to modify the elastomer of Pan to be a polyurethane in order to utilize an elastomer used in the art in making antimicrobial grips.

It appears that the publication improperly defined PU as plutonium instead of polyurethane.

3. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480 as applied to claims 1-2 and 6 above, and further in view of Huang (5,695,418).

Pan lacks polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape.

Huang (5,695,418) discloses a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape (Fig. 4). In view of the patent of Huang (5,695,418) it would have been obvious to modify the grip of Pan to have a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape in order to utilize the advantages of Pan with a grip tape of Huang (5,695,418).

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480 as applied to claims 1-2 and 6 above, and further in view of 7-215811.

Pan lacks an antimicrobial metal being silver. 7-215811 discloses treating polyurethane foam with tin or silver to produce antibacterial effects (English Constitution). In view of 7-215811 it would have been obvious to modify the grip of 9-75480 to have an antimicrobial metal being silver in order to utilize an antimicrobial agent available in the market place.

5. Claims 9-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480 and 7-215811 as applied to claims 7-8 above, and further in view of Yasui.

Pan lacks an antimicrobial agent silver ion in a porous based carrier of a silica-alumina carrier and the concentration by weight of an inorganic antimicrobial agent is about 2%. Yasui discloses a urethane material (Col. 2, Lns. 65-67) for a grip (Col. 1, Lns. 21-27) for a fishing pole (fig. 1) having antibacterial and antifungal material (Col. 2, Lns. 61-64) in the form of inorganic material of silver in a porous (Col. 1, Lns. 53-56) silica-alumina (Col. 3, Lns. 8-20), BACTEKIRANI, NOVALON (Table 1) and the concentration by weight of an inorganic antimicrobial agent is from .2 to 3 % (Tables 1-2) in order to cause less skin irritation and offer improved durability (Col. 3, Lns. 8-20). In view of the patent of Yasui it would have been obvious to modify the grip of Pan to have a silver metal in a porous silica-alumina carrier having a concentration by weight of an inorganic antimicrobial agent being about 2% in order to cause less skin irritation and offer improved durability for an elastomer having an antibacterial agent.

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6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480, 7-215811 and Yasui as applied to claims 9-11 above, and further in view of applicant's disclosure.

Pan lacks an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12. The applicant admits a commercially available silica-alumina carrier containing silver is montmorillonite having the formula as defined by claim 12 [0027]. In view of applicant's disclosure it would have been obvious to modify the grip of Huang to have an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12 in order to utilize a silica-alumina carrier containing silver as an antimicrobial agent available in the market place.

7. Claims 16, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418) and 7-215811.

Pan lacks a grip being an elongated strip and an elastomer being polyurethane. Huang discloses a grip being an elongated strip (Fig. 1) and layer of polyurethane (Abstract). In view of the reference of Huang it would have been obvious to modify the grip of Pan to have a grip being a tape in order to utilize the advantages of Pan for a grip made from a strip. In view of the reference of Huang it would have been obvious to modify the elastomer of Pan to be a polyurethane in order to utilize an elastomer used in the art in making grips.

See paragraphs above for elements of structure previously rejected by Pan in view of Huang (5,695,418) and 7-215811.

8. Claims 17-18, 20-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418) and 7-215811 as applied to claims 16, 19 and 22 above, and further in view of Yasui and applicant's disclosure.

See paragraphs above for elements of structure previously rejected by Pan in view of Yasui and applicant's disclosure.

Response to Arguments

9. The arguments that it is improper to use the reference of Pan since the application was rejected under 112, first paragraph, for lack of enablement as well as 112, second paragraph objections for lack of unity and the application was subsequently abandoned are disagreed with. It is uncertain why the application was abandoned. There could be other reasons than agreeing with the examiners position to abandon a case. The argument that Pan has no teaching of any elastomer is disagreed with. Throughout the entire application grip rubber is being discussed. Clearly rubber is an elastomer. The argument that grip rubber cannot mean an elastomer due to only possible elastomeric substance disclosed is a PU resin explicitly defined as plutonium is disagreed with. Plutonium has the symbol Pu and it is well known in the market place to define polyurethane as PU. Due to this application being from a foreign inventor this could easily have been a translation error. Looking at the application as a whole everything would point to PU as being a polyurethane. Never-the-less due to the

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application not specifically disclosing polyurethane the examiner did not rely on this reference for this element of structure a polyurethane but on 9-75480 to show that it is known to use foamed polyurethane for elastomeric material for a grip where a grip has an antimicrobial ability. The argument that it is improper to use the reference of Pan due to Pan having a myriad of 112 second paragraph objections is disagreed with. Pan clearly leads one skilled in the art to have an elastomer immersed in a liquid containing an antibacterial agent allowing the antibacterial agent to attach to it [0011] with the antibacterial agent being tin (Sn) [0009]. 7-215811 shows that this is a known teaching for elastomers in order to make the elastomer have antibacterial abilities. It is agreed that there are some confusing aspects about the application of Pan but the examiner does not agree that nothing can be learned from the publication. The argument that 9-75480 does not disclose an elastomer layer comprising an antimicrobial agent is agreed with. However the reference of Pan already teaches this element of structure and the reference of 9-75480 is not needed to show this teaching. 9-57480 was used to show that it would have been obvious to modify the grip of Pan to have a grip being a tape and an elastomer being a polyurethane. The argument that Pan, Huang and 7-215811 fail to teach one skilled in the art an antimicrobial grip comprising a layer of polyurethane bonded to a layer of felt where silver is dispersed therein is disagreed with. Pan discloses an elastomer bonded to a textile layer with the elastomer having tin as an antimicrobial agent. Huang discloses an elastomer being polyurethane and 7-215811 discloses using tin or silver to impregnate therein (Verbal Translation First page Abstract) into a polyurethane to provide antimicrobial abilities. 7-215811 does not only

disclose coating but impregnating the polyurethane with tin or silver (Verbal Translation First page Abstract).

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

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slb/ 17 February 2005


STEPHEN BLAU
PRIMARY EXAMINER